

REMARKS/ ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

35 U.S.C. § 112, second paragraph, Rejections

Examiner rejected claims 1-7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,070,211 (hereinafter "Neal").

To establish a *prima facie* case of obviousness, certain criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. (MPEP 2143).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01).

In the present matter, Neal clearly does not suggest nor motivate modifying the disclosure of Neal to provide the load buffers as claimed by applicant.

Applicant respectfully submits that to suggest modifying Neal to provide the load buffers as claimed by applicant, would be an attempt to use impermissible hindsight afforded by applicants' claimed invention. (See MPEP ¶ 2141.01 and *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In addition, a statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time claimed invention was made' " because the references relied upon teach that all aspect of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine or modify the teachings of the reference. *Ex Parte Levengood*,

28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). (MPEP 2143.01).

In the present matter, there is no objective reason to modify the teachings of Neal to provide the load buffers as claimed by applicant.

CONCLUSION

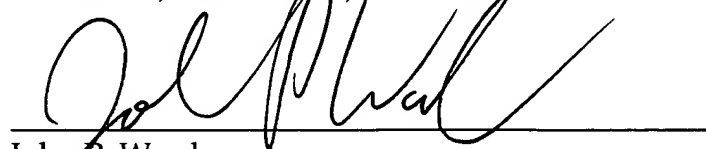
Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 10/21/03



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